

REMARKS/ARGUMENTS

In light of the above amendments and following remarks, reconsideration and allowance of this application are respectfully requested.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1 and 3-8 are pending in this application and have been rejected in the Office Action. By this Amendment, claims 9-15 are added. No new subject matter is added as a result of the new claims.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112, but rather the amendments and remarks made herein are simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. § 102(b)

In the Office Action, claims 1 and 3-8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by PCT Publication No. WO 95/32491 to Cho ("Cho"). The rejections are traversed for at least the following reasons.

As recited in independent claim 1, the instant memo sheet is comprised of, *inter alia*, a sheet member having a front side and a back side opposite to the front side. The sheet member is divided into a cover part and a hidden part by a fold line. Both parts have a marking face and a back face opposite to the marking face, where the marking faces are on the front side of the sheet member and the back faces are on the back side of the sheet member. On one of the back faces of the cover and hidden parts is a first removable pressure sensitive adhesive. On the back face of the cover part is a second removable pressure sensitive adhesive.

This configuration is depicted in FIG. 5, which shows that back faces 317 and 318 of the cover part 313 and the hidden part 314, respectively, are opposite to the marking faces 315 and 316 that are to be marked with messages. In addition, the first and second removable pressure sensitive adhesive layers 33 and 34 are provided on the back faces 317 and 318 of the cover part 313 and the hidden part 314, respectively, which are not marked with messages. *Instant Application*, page 5, lines 13-27. Therefore, both the first and second removable pressure sensitive adhesive layers are located on the back faces of the marking faces, or on the side opposite to the marking faces. As a result, marking in the form of writing or the like is done on the front side or marking face of the sheet member, which is opposite to the back side or back face of the sheet member that contains the first and second removable pressure sensitive adhesives.

Furthermore, after sheet member 31 is folded, the back faces 317 and 318 are adhered to each other and face inwardly in two opposite inward directions and the marking faces 315 and 316 are opposite to each other and face outwardly in two opposite outward directions. The marking face 315 and cover part 313 are therefore exposed and may be provided with marks to identify a message receiver and message sender, while the marking face 316 of the hidden part 314 is hidden as depicted in FIG. 6, and may therefore be provided with confidential messages. *Id.* at page 9, lines 1-12. The messages may be read by merely flipping the hidden part 314 up without the need to unfold the cover part 313 and hidden part 314.

As understood by Applicants, the Office Action is asserting that FIG. 1A of Cho is depicting a two-part sheet member, where FIG. 1A is showing the back face of the parts ("each part having a front face (not shown in figure-1A) and a back face (as can be seen)," *Office Action*, page 2, ¶ 5). As depicted, the first and second pressure sensitive adhesives 173 are included on the back side or back face of the sheet member. As the year, month and day

numbers included in FIG. 1A indicate, the back face depicted in the figure is also the marking face of the sheet member. Therefore, the marking face in Cho contains the pressure sensitive adhesives 173, unlike in the instant invention where the first and second removable pressure sensitive adhesives are located on the back side or faces of the marking faces.

Further, it is respectfully pointed out that in order for a Section 102 rejection to stand, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Applying the law to the instant facts, the sections of Cho relied upon by the Examiner in the Office Action do not provide a memo sheet that comprises a sheet member that has marking faces and back faces where the marking faces are arranged on a front side of the sheet member and the back faces are arranged on the back side of the sheet member, which are opposite to the marking faces and where the first and second removable pressure sensitive adhesives are provided on the back faces or side of the marking faces or sheet member. Consequently, Applicants respectfully request that the Section 102 rejections be withdrawn.

For at least the foregoing reasons, it is respectfully submitted that independent claim 1 patentably distinguishes over Cho and is therefore allowable. In addition, new claim 9 patentably distinguishes over Cho for the same reasons as claim 1. Further, claims 3-8 that depend from claim 1 and claims 10-15 that depend from claim 9 are allowable therewith.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

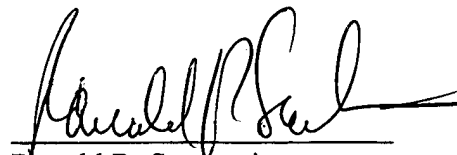
CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in black ink, appearing to read 'Ronald R. Santucci', written over a horizontal line.

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